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Paper No. 13  
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Brian Losh, Inc.

Serial No. 75/351,968

Lisa A. Osman of Dorsey & Whitney LLP for John Brian Losh, Inc.<sup>1</sup>

Mary E. Crawford, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney)

Before Hanak, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

<sup>1</sup> The attorney of record for applicant is Gary R. Duvall, of the firm of Graham & Dunn in Seattle, Washington. Mr. Duvall filed the initial application and all of applicant's responses to the Trademark Examining Attorney's various office actions. Gary M. Polumbus, of Dorsey & Whitney LLP in Denver, Colorado, filed applicant's notice of appeal. Lisa A. Osman, of the same firm, filed applicant's appeal brief. We have accepted the papers filed by Mr. Polumbus and Ms. Osman on behalf of applicant. However, because applicant has not filed a written request to change applicant's correspondence address, Mr. Duvall's address remains the correspondence address of record for applicant. See Trademark Rule 2.18, 37 C.F.R. §2.18; TMEP §603.04 (3d ed. 2002). Applicant's copy of the Trademark Examining Attorney's brief was sent to that address, and applicant's copy of this decision also shall be sent to that address.

Applicant seeks registration on the Supplemental Register of the mark LUXURY-REALESTATE.COM, in typed form, for Class 36 services recited as "providing information in the field of luxury real estate sales, and luxury real estate brokers, and links to related information, by means of a global computer network."<sup>2</sup>

The Trademark Examining Attorney has issued a final refusal to register the mark on the Supplemental Register, on the ground that the mark is generic and therefore incapable of distinguishing applicant's services. See Trademark Act Section 23, 15 U.S.C. §1091. Applicant has appealed the final refusal.

Applicant filed an appeal brief,<sup>3</sup> and the Trademark Examining Attorney filed an answering brief. Applicant did

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<sup>2</sup> The application, as originally filed on September 4, 1997, sought registration of the mark on the Principal Register. In response to the Trademark Examining Attorney's final refusal to register the mark on the Principal Register (on the ground of mere descriptiveness under Trademark Act Section 2(e)(1)), applicant amended the application on August 17, 1999 to one seeking registration on the Supplemental Register. The application is based on use in commerce under Trademark Act Section 1(a), and June 15, 1995 is alleged to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

<sup>3</sup> Applicant submitted numerous printouts of third-party registrations as exhibits to its appeal brief. The Trademark Examining Attorney properly objected to this proffered evidence on the ground of untimeliness. We sustain the objection, and we have not considered the exhibits to applicant's brief. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d).

not file a reply brief, nor did applicant request an oral hearing. We affirm the refusal to register.

The Trademark Examining Attorney has made of record numerous excerpts of articles obtained from the NEXIS automated database.<sup>4</sup> These articles, a representative and relevant sample of which are set out below (emphasis added), refer to "luxury real estate" as a type of real estate and/or a market category in the real estate industry:

But Naples has long been among the U.S. leaders in millionaires per capita. And when it comes to **luxury real estate** on the Gulf Coast, Naples is the king, much to the chagrin of Sarasota's elite realty brokers.  
(Sarasota Herald-Tribune, November 11, 2000);

The News received an invitation last week to a swanky reception at the Carnegie Hall Tower in New York, where a **luxury real estate** development was to be announced.  
(Denver Rocky Mountain News, October 22, 2000);

Dyson & Dyson Real Estate Associates, a Solana Beach, Calif., based **luxury real estate** firm, named Sally Pope broker-saleswoman...  
(Las Vegas Review-Journal, October 13, 2000);

Betty Brachman sells **luxury real estate** in one of the nation's hottest markets.  
(The San Francisco Examiner, October 8, 2000);

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<sup>4</sup> The various Web browser search result printouts made of record by the Trademark Examining Attorney are of little or no probative value because they do not provide adequate context for us to determine the nature, scope or significance of the uses of the searched-for term, "luxury real estate," in the retrieved Web sites.

Affordable is a relative concept, especially when it comes to housing in Westchester. Even modest family homes here can carry price tags that would guarantee **luxury real estate** in other parts of the country.  
(The New York Times, September 17, 2000);

The Santa Fe City Council voted in secret last month not to legally pursue **luxury real estate** developers who have reneged on promises to give the city money for affordable housing, some council members say.  
(Albuquerque Journal, August 25, 2000);

Mike Demos of Century 21 Demos & Co. has been named a member of the Unique Homes Registry of Distinction, the international referral network of luxury specialists. The program allows him to be in direct contact with more than 400 member brokers who market **luxury real estate** in the U.S. and abroad.  
(Asheville Citizen-Times (Asheville, NC), August 20, 2000);

The spring sell-off of technology stocks did not slow down the red-hot Bay Area **luxury real estate** market, the bank said.  
(The San Diego Union-Tribune, August 18, 2000);

Areas other than recreation destinations are booming. **Luxury real estate** across the country is awash in money and demand, said John Brian Losh, publisher of Who's Who in **Luxury Real Estate**, a Seattle publication.  
(Albuquerque Journal, August 7, 2000);<sup>5</sup>

Charlie Walldorf represented Herman Walldorf & Co. at a recent meeting of some of the nation's top **luxury real estate** brokers who discuss the current status and future market for **luxury real estate**... Mr. Walldorf attended the Who's Who in **Luxury Real Estate** Conference in Hawaii hosted by publisher John Brian Losh. The

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<sup>5</sup> John Brian Losh, to whom the statement in this excerpt is attributed, is the president of applicant.

Walldorf firm is a member of the international **luxury real estate** brokerage network.  
(Chattanooga Free Press, May 24, 1998);<sup>6</sup>

Otis Mead of Mead Associates Inc. in Lexington has been named among the top **luxury real estate** brokers in the country by Unique Homes magazine.  
(Roanoke Times & World News, June 18, 2000);

The purchase is part of G.M.A.C. Home's plan to develop its operations in central New Jersey and to focus on sales of **luxury real estate** in New Jersey.  
(The New York Times, April 20, 2000);

Chicago writer Bob Goldsborough's column on **luxury real estate**, "Upper Bracket," appears in the Tribune's Real Estate section.  
(Chicago Tribune, April 16, 2000);

The overall observation of the Luxury Property Report for 1999 is that, for the reasons outlined above, there is exceptional current strength in **luxury real estate** across all categories - cooperatives, condominiums, townhouses and lofts.  
(Real Estate Weekly, April 12, 2000);

The Manhattan **luxury real estate** market fell 8 percent last year following stocks' 19 percent dip.  
(The Washington Times, September 8, 1999);

Beauchamp, who has been in the **luxury real estate** business in South Florida for two decades, said the market has never been better than it is right now.  
(Sun-Sentinel (Fort Lauderdale, FL), June 28, 1999).

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<sup>6</sup> Again, this appears to be a reference to applicant's president.

Other of the NEXIS excerpts in the record refer to the fact that, in addition to applicant's Internet Web site, there are third-party Web sites which provide real estate information, including real estate Web sites which provide information about luxury real estate. For example:

Mr. Walldorf attend the Who's Who in Luxury Real Estate Conference in Hawaii hosted by publisher John Brian Losh. The Walldorf firm is a member of the international luxury real estate brokerage network. . . The average price of some 1,500 properties on the luxury real estate Web site is about \$1 million. (Chattanooga Free Press, May 24, 1998);<sup>7</sup>

Symtezzi LLC has launched a new corporate Web site for Christie's Great Estates, the Santa Fe-based real estate marketing arm for Christie's Auction House of London and New York. The Web site reflects the company's mission to market and sell luxury real estate around the world. By showcasing luxury properties on the Internet, Christie's expects to have an immediate effect on the sale of more than 300 properties currently listed. (Albuquerque Tribune, November 20, 2000);

Marketing of upper-end homes has become easier with the development of real-estate Web sites on the Internet. These properties, usually representing the upper 10 percent of homes on the market, require world-wide exposure to find the right buyer. (The Stuart News/Port St. Lucie News (Stuart, Florida), December 19, 1999);

More and more real estate information is available online. The Tribune's real estate

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<sup>7</sup> This appears to be a reference to applicant's Web site. See *supra* at footnote 6.

Web site, filled with data on area communities, is at [chicago.tribune.com/go/homes](http://chicago.tribune.com/go/homes).  
(Chicago Tribune, February 7, 1998);

Here's how Lincoln-based Gomez Advisors ranks 15 real estate Web sites based on ease of use, customer confidence, on-site resources and services.  
(The Boston Globe, January 31, 2000);

The booklet Fifty Great Real Estate Freebies tells readers how to obtain dozens of free publications about a variety of realty topics and includes a new supplement of the 25 most useful real estate Web sites.  
(The Times-Picayune, January 22, 2000);

The idea is to set Owners.com apart from other real estate Web sites that only include homes listed with brokers.  
(ADWEEK, December 20, 1999);

The battle of real estate Web sites rages on. The key residential real estate sites, competing for broker and consumer participation, are Realtor.com and NomeAdvisor.com . . . Realtor.com is operated by Homestore.com, a family of real estate Web sites based in Thousand Oaks, California.  
(The Stuart News/Port St. Lucie News (Stuart, FL), December 9, 1999).

Trademark Act Section 23 provides for registration on the Supplemental Register of marks "capable of distinguishing applicant's goods or services and not registrable on the Principal Register." Generic terms, i.e., terms that the relevant purchasing public understands primarily to refer to the genus of goods or services in question, are by definition incapable of indicating a

particular source of the goods or services, and they therefore are not registrable on either the Principal Register or the Supplemental Register. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); and *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The determination of whether the term sought to be registered is generic involves a two-part inquiry: "First, what is the genus of the goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp.*, *supra*, 228 USPQ at 530. Evidence of the relevant public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. *In re Merrill Lynch*, *supra*. The Office bears the burden of proving the term generic. *In re Dial-A-Mattress Operating Corp.*, *supra*.

Addressing the first part of the *Ginn* genericness inquiry, we find that the genus of services at issue in



this case is that of "information services in the field of luxury real estate, provided via the Internet."<sup>8</sup> We base this finding on the fact that applicant itself essentially identifies its services this way in the recitation of services in the application, i.e., "providing information in the field of luxury real estate sales, and luxury real estate brokers, and links to related information, by means of a global computer network." Applicant's specimens likewise refer to applicant's services in terms of the provision of information about luxury real estate via the Internet: "Consumers from around the world are using the Internet to find information about the luxury real estate market," and "We've created the world's most comprehensive network of luxury real estate brokerages and made them available to over 60 million users on the Internet." Furthermore, the record shows that, in addition to applicant's Web site, there are other Web sites which provide real estate information, including information about luxury real estate.

Thus, based on applicant's own recitation of services and the statements made in applicant's specimens, and on

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<sup>8</sup> We reject applicant's contention (at page 4 of its brief) that the genus of services at issue in this case is "real estate services."

the fact that there are others who offer similar information services, we find that the genus of services in this case is that of "information services in the field of luxury real estate, provided via the Internet." See generally *H. Marvin Ginn Corp.*, *supra*, wherein the court, in identifying the genus of goods at issue, looked to the identification of goods in the registration and to the fact that others offered similar goods.<sup>9</sup>

We turn next to the second part of the *Ginn* genericness inquiry: whether the matter applicant seeks to register, LUXURY-REALESTATE.COM, is understood by the relevant public primarily to refer to the genus of services at issue, i.e., "information services in the field of luxury real estate, provided via the Internet." We find that it is so understood.

First, the evidence of record (see *supra* at pages 3-7) shows that "luxury real estate" is the name of a particular, commercially discrete field in the real estate industry.<sup>10</sup> It is that field to which applicant's Internet

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<sup>9</sup> "Here, Ginn's registration is of the title of 'a magazine directed to the field of fire fighting.' In addition to Ginn's publication, the record shows that there are a number of other publications directed to that field. The class of magazines at issue is, therefore, those directed to the field of fire fighting." *H. Marvin Ginn Corp.*, *supra*, 228 USPQ at 532.

<sup>10</sup> Applicant's argument that "luxury real estate" is not a separate genus but rather a species of the genus "real estate" is

information services, and the similar services of others, are directed. Because "luxury real estate" is the generic name of the particular field or industry which comprises the subject matter of applicant's information services, we find that it likewise is a generic name for the information services themselves. Anyone wishing to provide Internet information services regarding this particular field, i.e., "luxury real estate," would need to use, and is entitled to use, this generic name in connection with such services.

The Board has repeatedly held that a term which is the generic name of a particular field or class of goods or services is likewise generic for any services which are directed to or focused on that field or class of goods or services. *See, e.g., In re A La Vieille Russie Inc., supra* (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field); *In re*

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not persuasive. We agree instead with the Trademark Examining Attorney's contention, which the evidence bears out, that "luxury real estate" is a sub-genus of "real estate," a recognized, separate commercial category or field within the real estate industry. *Cf. In re A La Vielle Russie Inc., 60 USPQ2d 1895 (TTAB 2001)* ("Russian art" shown to be distinct type of art and commercial category within the art market). For the same reasons, we are not persuaded by applicant's related argument that "luxury" is a merely descriptive term modifying the generic term "real estate," and that "luxury real estate" therefore is not a generic term when considered in its entirety because it is made up of a merely descriptive term combined with a generic term. The evidence of record shows that "luxury real estate" is a unitary term which is used and understood to be the name of a particular field or category in the real estate industry.

*Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999)(because LOG CABIN HOMES is generic for a particular type of building, it is also generic for architectural design services directed to that type of building, and for retail outlets featuring kits for construction of that type of building); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998)(because WEB COMMUNICATIONS is generic for publication and communication via the World Wide Web, it is also generic for consulting services directed to assisting customers in setting up their own Web sites for such publication and communication); and *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984)(LAW & BUSINESS incapable of distinguishing applicant's services of arranging and conducting seminars in the field of business law). See also *In re Northland Aluminum Products*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985)(BUNDT generic for type of cake, ergo also generic for applicant's ring cake mix); and *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1989)(PERMA PRESS generic not only for a type of fabric but also for soil and stain removers designed for use on that particular type of fabric).

Additionally, our finding that "luxury real estate" is generic as applied to Internet information services directed to the field of luxury real estate is consistent

with the findings made in various cases involving magazine titles,<sup>11</sup> i.e., that the generic name of a particular trade or industry is likewise a generic name for the class of publications directed to that particular trade or industry. See, e.g., *Jenkins Publishing Co. V. Metalworking Publishing Co., Inc.*, 139 USPQ 346 (TTAB 1963)(METALWORKING generic for trade magazine directed to the metalworking industry). Similarly, in *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 1136, 188 USPQ 612 (2d Cir. 1975), the Second Circuit found that CONSUMER ELECTRONICS, which the plaintiff had registered on the Supplemental Register and which served as the basis for plaintiff's claim that its mark CONSUMER ELECTRONICS MONTHLY was infringed by defendant's mark CONSUMER ELECTRONICS PRODUCT NEWS, was generic as applied to trade magazines directed to the consumer electronics industry: "It would be difficult indeed for other trade magazines to flourish and identify themselves to a relevant readership if they were forbidden to use the common name of the trade in their titles." In *Reese Publishing Company, Inc. v. Hampton International Communications Inc. et al.*, 620 F.2d 7, 205 USPQ 585 (2d

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<sup>11</sup> Professor McCarthy notes: "Many web sites are essentially electronic magazines, offering information about certain topics." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition Law §7:17.01 (4th ed. 12/2000).

Cir. 1980), the Second Circuit used the same analysis in finding VIDEO BUYER'S GUIDE to be generic for a consumer magazine about video products. The court also noted, in dicta: "We believe that 'video,' like 'consumer electronics,' is a generic term describing a particular class of products and that the term is the name of a trade or industry. Therefore, if plaintiff sought trademark protection for 'Video' as its magazine title, we think it would fail."

The same analysis was used by the court in *Walker-Davis Publications, Inc. v. Penton/IPC, Inc.*, 509 F.Supp. 430, 211 USPQ 265 (E.D. Pa. 1981). In that case, as noted by the Federal Circuit in *H. Marvin Ginn Corp., supra*, 228 USPQ at 531:

the court held that the term "Energy Management" is a name which refers to a particular industry and thus names a class of trade magazines, as well as a trade or field of interest, by giving itself the name of the trade or field which is the exclusive subject of its advertisements and articles. It is therefore, said the court, a generic name not capable of valid registration. 509 F.Supp. at 438, 211 USPQ at 272. As was the case in *CES* and *Reese*, *supra*, the title at issue in *Walker-Davis* was the specific term understood by the relevant public as the common name of the industry itself.

Distinguishing *CES*, *Reese* and *Walker-Davis*, the Federal Circuit concluded in *H. Marvin Ginn Corp.* that FIRE CHIEF is not generic for a magazine directed to the field of fire fighting, because there was no evidence that the public refers to a class of fire fighting magazines as FIRE CHIEF, but also because FIRE CHIEF "is neither the name of the fire-fighting industry nor about the fire-fighting industry." 228 USPQ at 532.

The same rationale applies in this case. Because "luxury real estate" is the generic name of a particular field or industry, it would be generic as the title of a magazine directed to the field of luxury real estate. It is no less generic as applied to Internet information services directed to that field.

In sum, because "luxury real estate" is generic for the particular field or industry to which applicant's Internet information services are directed, it is generic for those services as well.

Applicant argues, however, that even if "luxury real estate" is generic for applicant's services, such is not applicant's mark:

Here, Applicant employs several stylized features to vary the appearance of its Mark from the ordinary and to give it the modest distinguishability and distinctiveness required

for registration on the Supplemental Register. Applicant's mark is not the phrase found by the Examining Attorney to be generic, namely "Luxury Real Estate." Instead, Applicant's Mark is a stylized representation of that phrase. Applicant segments its Mark by incorporating a hyphen between the "luxury" and "real estate" components. Additionally, the "real estate" component is presented as one word, i.e., "realestate." Taken together these features create a Mark that has a unique visual appearance and is sufficiently varied from the ordinary such that it is capable of distinguishing Applicant's services. Therefore, Applicant's Mark is eligible for registration on the Supplemental Register.

(Applicant's brief at 6-7.)

We disagree. It is settled that "a misspelling of a generic name which does not change the generic significance to the buyer, is still generic." McCarthy, *supra*, at §12:38. This includes misspellings of the type relied on by applicant in this case, i.e., the insertion of hyphens, and the compression of two words into a single word. *See, e.g., Nupla Corp. v. IXL Manufacturing Co.*, 114 F.3d 191, 42 USPQ2d 1711 (Fed. Cir. 1997)(CUSH-N-GRIP generic for hand tools); *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987)(SCREENWIPE generic for premoistened antistatic cloths for cleaning computer and television screens); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970)(CUSTOMBLENDED generic for custom blended gasoline); *Cummins Engine Co. v. Continental Motors*



*Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966)(TURBODIESEL generic for internal combustion engines); *In re A La Vieille Russie, Inc.*, *supra* (RUSSIANART generic for art dealership services); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1998)(MASSFLO generic for meters that measure mass flow of fluid); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987)(MINERAL-LYX generic for livestock mineral supplement in lick form); and *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534 (TTAB 1987)(WASHWAX generic for product which simultaneously washes and waxes a vehicle).

As in the cited cases, we find that LUXURY-REALESTATE creates the same commercial impression as LUXURY REAL ESTATE, and that it therefore is equally generic as applied to applicant's services. The mere addition of the hyphen after LUXURY, and the obvious misspelling of REAL ESTATE as REALESTATE, are de minimis, insignificant stylizations which create no new or different commercial impression than that created by the generic words LUXURY REAL ESTATE. Those slight stylizations are insufficient to transform the generic term into a non-generic term.

Finally, we find that the presence of ".COM" in the matter applicant seeks to register does not negate or mitigate the genericness of the designation as a whole.

".COM" is merely an Internet top level domain indicator<sup>12</sup> which, like an entity designation such as "Co." or "Inc.," has no source indicating significance or capability. See *In re Martin Container, Inc.*, \_\_\_ USPQ2d \_\_\_, (TTAB June 11, 2002); see also McCarthy, *supra*, at §7:17.1. Applicant, in its appeal brief, has not contended otherwise. We also find, for purposes of the analysis set forth in *In re Dial-A-Mattress Operating Corp.*, *supra*, and for the reasons discussed in *In re Martin Container Corp.*, *supra*, that LUXURY-REALESTATE.COM is a "compound term" rather than a "phrase," and that the combination of the generic term LUXURY-REALESTATE and the top level domain indicator .COM fails to create a composite which has any source-indicating significance or capability. See *In re Gould Paper Corp.*, *supra*. Again, applicant has not contended otherwise in its brief.

In summary, we find that the matter applicant seeks to register on the Supplemental Register, i.e.,

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<sup>12</sup> ".com" is defined as: "a domain type used for Internet locations that are part of a business or commercial enterprise" CNET Glossary (1998); "abbreviation of commercial organization (in Internet addresses)" The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000); and "Internet abbreviation for company: used to show that an Internet address belongs to a company or business" Cambridge Dictionaries Online (2001). We take judicial notice of these definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982).

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LUXURY-REALESTATE.COM, is generic as applied to applicant's services, and that it therefore is incapable of distinguishing applicant's services and is unregistrable on the Supplemental Register.

Decision: The refusal to register is affirmed.